



PTO/SB/33 (07-09)

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**PRE-APPEAL BRIEF REQUEST FOR REVIEW**Docket Number (Optional)  
1740-000076/US

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

Application Number  
10/720,121Filed  
November 25, 2003First Named Inventor  
Kang Soo SEO

On \_\_\_\_\_

Art Unit  
2621Examiner  
Hung Q. Dang

Signature \_\_\_\_\_

Typed or printed name \_\_\_\_\_

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.


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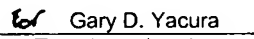
☐ applicant/inventor

☐ assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)

☒ attorney or agent of record.  
Registration number 35,416.

☐ attorney or agent acting under 37 CFR 1.34.  
Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

  
Reg. No. 56,205  
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Gary D. Yacura  
Typed or printed name

(703)668-8000  
Telephone number

November 9, 2009  
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

☐ \*Total of \_\_\_\_\_ forms are submitted.



**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Application No.: 10/720,121                      Group Art Unit: 2621  
Filing Date: November 25, 2003              Examiner: Hung Q. Dang  
Applicant: Kang Soo SEO et al.  
Title: METHOD FOR RECORDING A DATA STREAM HAVING  
MULTIPLE REPRODUCTION PATHS AND A RECORDING  
MEDIUM HAVING THE DATA STREAM  
Attorney Docket: 1740-000076/US

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401 Dulany Street  
Alexandria, VA 22314  
**Mail Stop AF**

November 9, 2009

**STATEMENT UNDER 37 C.F.R. § 1.133(b)**

Sir:

In response to the telephonic interview conducted on September 9, 2009 and the Interview Summary dated September 14, 2009, the following remarks are respectfully submitted in connection with the above-identified application.

**Interview Summary**

Applicants wish to thank the Examiner for his time during the telephonic interview of September 9, 2009. During the interview, Applicants and the Examiner discussed the merits of claim 1 relative to prohibiting a reproduction path re-change to a most recent previous path after reproduction path change. More specifically, Applicants and the Examiner discussed the Examiner's reliance on Taira (US 2003/0113096).

At the conclusion of the interview, no agreement was reached. Consequently, Applicants have filed a Notice of Appeal, a Pre-Appeal Request for Review and Reasons for Pre-Appeal Request for Review.

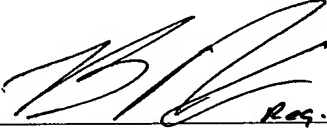
**CONCLUSION**

Should there be any outstanding matters that need to be resolved in the present application; the Examiner is respectfully requested to contact the undersigned at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

HARNESS, DICKEY, & PIERCE, P.L.C.

By  Reg. No. 35,416  
for Gary D. Yacura, Reg. No. 35,416

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**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Application No.: 10/720,121                      Group Art Unit: 2621  
Filing Date: November 25, 2003              Examiner: Hung Q. Dang  
Applicant: Kang Soo SEO et al.  
Title: METHOD FOR RECORDING A DATA STREAM HAVING MULTIPLE  
REPRODUCTION PATHS AND A RECORDING MEDIUM HAVING  
THE DATA STREAM  
Attorney Docket: 1740-000076/US

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November 9, 2009

**REASONS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Sir or Madam:

In response to the Office Action dated April 28, 2009, the due date being extended two (2) months to November 9, 2009, Appellants request that an appointed panel of Examiners (hereinafter "the Panel") review the pending rejections.

**I. MATERIAL UNDER REVIEW**

Claims 1-28 are pending in this application. Claims 1, 11, 17 and 23 are independent claims.

Claims 1-9 and 11-28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Yamane et al. (US 5,784,528), hereinafter "Yamane," in view of Taira et al. (US 2003/0113096), hereinafter "Taira."<sup>1</sup>

Claim 10 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Yamane in view of Taira and Fujiwara et al. (US 2003/0113096), hereinafter "Fujiwara."<sup>2</sup>

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<sup>1</sup> Final Office Action, U.S. Appln. No. 10/720,121, U.S. Pat. and Trademark Office, p. 3 (June 9, 2009).

**A. INDEPENDENT CLAIMS 1, 11, 17 AND 23**

Claim 1 is directed to a method for recording a data stream having multiple reproduction paths on a recording medium. Relevant portions of claim 1 are provided below for the Panel's convenience.

1. A method for recording a data stream having multiple reproduction paths on a recording medium, comprising:

checking whether total bit rate (TBR) of a data stream section pertaining to one path among multiple reproduction paths is lower than a minimum bit rate;

...

wherein the data stream section is a section which prohibits reproduction path re-change to a most recent previous path after reproduction path change, based on a buffering condition.

Each of claims 11, 17 and 23 contains its own individual features. However, all of claims 11, 17 and 23 also recite "wherein the data stream section is a section which prohibits reproduction path re-change to a most recent previous path after reproduction path change, based on a buffering condition."

**II. A PRIMA FACIE CASE OF OBVIOUSNESS HAS NOT BEEN ESTABLISHED**

The Examiner bears the initial burden of presenting a prima facie case of obviousness in rejecting claims under 35 U.S.C. § 103. *See In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993).

Generally, each element of the claim must be known in the prior art for the claim to be obvious. *See generally, KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 415-16, 82 USPQ2d 1385, 1395.

At least the prohibiting "reproduction path re-change to a most recent previous path after reproduction path change," is not disclosed or suggested by Yamane, Taira and Fujiwara, either alone or in combination. Therefore, the Examiner has failed to establish a prima facie case of obvious.

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<sup>2</sup> Id.

**A. CLAIMS 1-9 AND 11-28 ARE NONOBVIOUS OVER YAMANE IN VIEW OF TAIRA.**

**i. SUMMARY OF LAW**

An Examiner may rely on the “express, implicit and inherent disclosures” of a reference. MPEP § 2112.

In establishing that an element is inherent in a reference, the missing element must be necessarily present in the apparatus described in the reference(s) such that the presence of these elements would be recognizable by persons of ordinary skill. *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

“The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish inherency of that result or characteristic.” MPEP § 2112(IV). Probabilities or possibilities are not sufficient. *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-1951 (Fed. Cir. 1999). “The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *Id.*

**ii. ANALYSIS**

As a preliminary matter, Appellants maintain the arguments set forth in the Amendment filed on April 9, 2009.

As admitted by the Examiner on page 4 of the Office Action dated June 9, 2009, “Yamane et al. do not explicitly disclose prohibiting the reproduction path re-change to a most recent previous path,” as required by claim 1. Instead, the Examiner relies on Taira for this teaching.

Taira discloses a playback screen wherein some or all of a plurality of angles or scenes can be played back simultaneously. Paragraph [0340] of Taira discloses an example of seamless angle switching. More specifically, paragraph [0340] of Taira provides the following:

The angle cannot be immediately switched from the second unit of angle #2 (AGL2-2) to the second unit of angle #3 (AGL3-2) for the following reason. That is, the two angle units (AGL2-2 and AGL3-2) form an angle block to be played back in an identical time band. The unit of seamless angle switching is each ILVU that forms an angle playback unit. However, when angle switching is done between ILVUs in an identical time band (the ILVUs of AGL2-2 and AGL3-2), the flow of movie playback becomes temporally discontinuous (non-seamless), and temporally continuous, seamless angle switching cannot be done until the next angle block (AGL3-3). For this reason, the angle is prohibited from being

immediately switched from the second unit of angle #2 (AGL2-2) to the second unit of angle #3 (AGL3-2).

In order to allege that the “prohibiting reproduction path re-change to a most recent previous path after reproduction path change,” of claim 1 is taught by Taira, the Examiner asks Appellants to, “consider the assumption that the angle #3 was being played back before it is switched to playback of angle #2.”<sup>3</sup>

However, the Examiner has not established that “prohibiting reproduction path re-change to a most recent previous path after reproduction path change,” is inherent to the disclosure of Taira.

First, an assumption is not sufficient to establish that a feature is inherent. “The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *Robertson*, 169 F.3d at 745.

Moreover, paragraph [0340] of Taira even provides the opposite of the Examiner’s assumption because angles can be switched back and forth regardless of the previous angle.

Therefore, Taira fails to disclose or suggest the “prohibiting reproduction path re-change to a most recent previous path after reproduction path change,” as required by claim 1.

Consequently, Yamane and Taira, either alone or in combination, fail to render claim 1 obvious. Claims 2-9, which are dependent on claim 1, are patentable for at least the reasons set forth above regarding claim 1.

Claims 11, 17 and 23 are separate independent claims from claim 1, wherein each independent claim contains its own individual limitations. Each independent claim should be interpreted solely based upon limitations set forth therein. However, claims 11, 17 and 23 are patentable for at least reasons somewhat similar to those set forth above regarding claim 1. Claims 12-16, 18-22 and 24-28, which are dependent on claim 11, 17 or 23, are patentable for at least the reasons set forth above.

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<sup>3</sup> Final Office Action, U.S. Pat. Appln. No. 10/720,121, U.S. Pat. and Trademark Office, p. 4 (June 9, 2009).

**B. CLAIM 10 IS NONOBVIOUS OVER YAMANE IN VIEW OF TAIRA.**

Claim 10 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Yamane in view of Taira and Fujiwara et al. (US 2003/0113096), hereinafter "Fujiwara." Applicants traverse this rejection for the following reasons.

The Examiner correctly acknowledges that the features of claim 10 are absent from Yamane in view of Taira, but alleges that these features are taught by Fujiwara, thereby rendering claim 10 obvious to one of ordinary skill at the time of the invention. Even assuming *arguendo* that the features of claim 10 are taught by Fujiwara (which Applicants do not admit) and that Fujiwara could be properly combined with Yamane and Taira (which Applicants do not admit), Yamane, Taira and Fujiwara are still deficient with respect to the above-described features of claim 1. Thus, even in combination, Yamane, Taira and Fujiwara fail to render claim 10 obvious.

**III. CONCLUSION**

In view of the above remarks, Appellants respectfully request that the Panel withdraw the grounds of rejection and allow the pending claims.

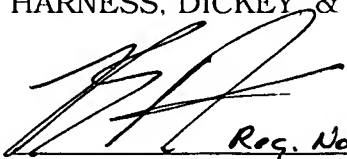
Should there be any outstanding matters that need to be resolved in the present application; the Examiner is respectfully requested to contact the undersigned at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

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